

Appl. No. 09/931,677  
Amdt. Dated March 1, 2007  
Reply to Office Action of November 30, 2006

**Amendments to the Drawings:**

The attached sheet of drawing includes new sheet Figure 4.

Attachment:      New Sheet

### **REMARKS/ARGUMENTS**

Claims 1-11 are pending in the present application.

This Amendment is in response to the Office Action mailed November 30, 2006. In the Office Action, the Examiner objected to claims 1-11 due to minor informalities; rejected claims 1-3 under 35 USC §112, first paragraph, as not enabling; rejected claims 4 and 7 under 35 USC §112, first paragraph, as based on lack of disclosure; rejected claims 1-3 under 35 USC §112, second paragraph, as being incomplete for omitting essential elements; rejected claims 1-11 under 35 USC §102(b). Applicant has amended claims 1-3, the Specification and added a new Figure 4. Applicant submits that no new matter has been introduced. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Examiner's interview***

In response to the Examiner's invitation of contacting the Examiner to discuss the invention (Office Action, page 5, lines 3-4), Applicant conducted an interview with the Examiner on December 14, 2006 to discuss the proposed amendment and to clarify the invention. In accordance to the Examiner's request, Applicant has amended the Specification and the drawings to clarify the claimed invention.

#### ***Responses to Examiner's arguments***

1. The Examiner states that the amendments to the specification and the new drawing will not be entered since it appears that they contain new matter. Specifically, the Examiner states that the original application does not refer to any "Super Cheap Store" and a link between the "Super Cheap Store" system and the Retailer's POS system where the coupon is redeemed as featured in new figure 4 (Office Action, page 2, lines 1-6). In response, Applicant has amended the Specification and the drawings to clarify the claimed invention.

Accordingly, Applicant respectfully request the amendments be entered.

2. The Examiner contends that Applicant has left a lot of details out of the specification by assuming that all those details are well known and has drafted claims that are substantially based on those supposedly well known features. Applicant respectfully disagrees. The claims recite elements that are not disclosed or suggested in the cited prior art references. The Examiner's contention that "if those features are so well known that they are being omitted from

the detailed description, then they cannot be novel” is misplaced. Applicant does not claim the omitted features. The Examiner has not specifically pointed out which omitted features that are recited in the claims.

The Examiner further contends that although there is not 112(1)-enablement problem here, nonetheless, there is a potential 112(1) for lack of disclosure (Office Action, page 2, last sentence). Applicant respectfully disagrees. There is no such thing as a lack of disclosure in the first paragraph of 35 USC §112. The first paragraph of 35 USC §112 provides only three requirements: written description, enablement, and best mode. The Examiner has not cited a valid rejection in rejecting the claims.

The Examiner further contends that one of ordinary skilled in the art can reach the same conclusion upon reading or reviewing the specification. Applicant respectfully disagrees. The Examiner has not specifically pointed out what conclusion recited in the claim language that may be reached by one of ordinary skilled in the art.

The Examiner further contends that Fajkowski discloses a system in which coupons are scanned into the coupon card by the user or downloaded from the plurality of sources (Office Action, page 3, lines 4-5). However, the claimed invention does not scan coupons into a coupon card. The claimed invention provides for a wallet card that is related to a notification indicia on publicly placed coupons or advertisements so that any coupon so marked is redeemable by using only the wallet card rather than the coupon itself (Specification, page 9, lines 16-21).

### ***Specification***

In the Office Action, the Examiner contends that the Specification suffers from a complete disclosure by assuming that the details are well known in the art. The Examiner further alleges that although these details are well known in the art, the lack of disclosure can trigger a §112(1) for insufficient support (Office Action, page 3). However, the Examiner has not pointed out what details need to be clarified. A §112, first paragraph, requirement includes three separate and distinct requirements: the written description, the enablement, and the best mode requirements. Apparently, the Examiner relies on the written description requirement in making the allegation.

An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The Examiner, however, has not proved that the disclosure of the application does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter.

The Examiner further states that it is not clear (1) whether the customer presents the coupon wallet at a retailer's POS to redeem at least one coupon having this noticeable mark imprinted thereon, or (2) whether the coupon having this noticeable is presented for redemption or (3) the coupon data are electronically transmitted to the retailer's POS database where the coupon wallet is used as a piece of ID to identify the customer during a transaction or redemption process (Office Action, page 4).

As discussed with the Examiner during the Examiner's Interviews on June 15, 2006 and December 14, 2006, the claimed invention is a wallet card that is related to a notification indicia on publicly placed coupons or advertisements so that any coupon so marked is redeemable by using only the wallet card rather than the coupon itself (Specification, page 9, lines 16-21). The card has information contained in a magnetic stripe, printed barcode, imbedded circuitry with memory, etc. (Specification, page 9, lines 8-10). The wallet card is scanned or otherwise used to identify the purchaser (Specification, page 10, lines 4-5). The manager alerts the manufacturers and retailers to the benefits of the method of using this card and enlists such manufacturers and retailers as wish to participate (Specification, page 9, lines 12-14). Accordingly, when the

consumer presents the card to the retailer, the retailer can provide discount based on the relationship established between the retailer and the management entity (Specification, Figs 1-3).

To clarify the claimed invention, Applicant has amended the Specification to include the description of the wallet card and the use of the wallet card to obtain discount. Applicant has also amended the drawings to include Figure 4.

Accordingly, Applicant believes that claims 1-11 are in condition for allowance.

### ***Claim Objection***

The Examiner objected to claims 1-11 due to informalities. Specifically, the Examiner states that "publically" should be changed to "publicly". In response, Applicant has amended claims 1-3 to correct the minor informalities.

Accordingly, Applicant respectfully request the claim objections be withdrawn.

### ***Claim Rejections – 35 USC §112***

#### **1. Claims 1-3:**

In the Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. Specifically, the Examiner contends that neither the specification nor the claims discloses (1) how the paper coupons are redeemed by the retailer's POS in conjunction with the wallet card or (2) shows whether coupon data, related to a paper coupon having that noticeable mark, are electronically transmitted to the retailer's POS database. Applicant respectfully disagrees for the following reasons.

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without

undue experimentation." ). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). Furthermore, as long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

The claimed invention focuses on a technique to use a wallet card to replace coupons. Among other things, claim 1 recites: (1) identifying selected publicly placed coupons, offering a purchase discount for a selected product, with a notification indicia related to the one of the wallet cards; (2) issuing the purchase discount for the selected product purchased at one of the plurality of retailers by the one of the plurality of consumers upon presentation of the one of the wallet cards; and (3) notifying the management entity of the purchase discount identified to the management entity via the electronic automated means.

The Specification provides ample support for the claim, including at least one method for making and using the claimed invention. See, for example, Specification, page 9, lines 12-14 ("The manager also alerts the manufacturers 30 and retailers 40 to the benefits of the method of this invention and enlists such manufacturers and retailers as wish to participate."); page 9, lines 28-29 and page 10, line 1 ("Upon the purchase of a product offered by a retailer, where the product may be redeemed by a related coupon, the wallet card is presented instead, the retailer provides the requisite discount to the consumer as if the consumer had presented the physical coupon."); and page 11, lines 13-15 ("Preferably, the retailer 40 notifies the manager 10 of each of the purchase discounts issued via an electronic means such as the national consumer credit card system uses.").

The Examiner further contends that "it appears that the specification only supports encoding or storing other information, but not expressly scanned coupon data, into the coupon wallet card." (Office Action, page 6, lines 8-9). Applicant respectfully disagrees. The claims do not recite scanning coupon data into the coupon wallet card. Accordingly, the Examiner is arguing something that is not recited in the claims.

The Examiner has not shown that if any experimentation is necessary, it is undue. Furthermore, the Examiner has not shown that the specification does not disclose at least one

method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim. On the contrary, as discussed above, the Specification provides ample support for the claims. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, is improperly made.

2. Claims 4 and 7:

The Examiner rejected claims 4 and 7 under 35 U.S.C. 112, first paragraph, as based on a lack of disclosure. Specifically, the Examiner contends that “it appears that the specification does not immediately support storing transaction information and/or coupon data in the memory of the wallet card before distributing the card to the user.” (Office Action, page 6, lines 15-17). Applicant respectfully disagrees for the following reasons.

First, claims 4 and 7 do not recite the limitation “storing transaction information and/or coupon data in the memory of the wallet card before distributing the card to the user.” It is noted that the wallet card is used as a vehicle to replace physical coupons. Therefore, it is not necessary to storing transaction information and/or coupon data in the memory of the wallet card.

Second, the Specification does provide support for storing the information in the wallet card. See, for example, page 9, lines 7-10 (“These cards provide, either on their faces, within the body of the card, or both, certain information. This information may, for instance, be contained in a magnetic stripe, printed bar code, imbedded circuitry with memory, etc.”).

Accordingly, the rejection under 35 U.S.C. §112, first paragraph, is improperly made.

3. Claims 1-3:

The Examiner rejected claims 1-3 under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements, while rendering the claims ambiguous (Office Action, page 6, lines 18-20). Specifically, the Examiner contends that “it is not clear whether the customer presents the coupon wallet at the retailer’s POS to redeem at least one coupon having this noticeable mark imprinted thereon or whether the coupon having this noticeable [mark] is presented for redemption or the coupon are electronically transmitted to the retailer’s POS database where the coupon wallet is used as a piece of ID to identify the customer during a transaction or redemption process. In the case the coupon data are scanned or encoded into the wallet or they

are electronically transmitted to the retailer's database, the means to do so are not provided therein." (Office Action, page 7, lines 1-8). Applicant respectfully disagrees for the following reasons.

First, apparently the Examiner raises the same issue that was fully addressed in the previous response filed on August 28, 2006 and thoroughly discussed with the Examiner during the Examiner's interviews on June 15, 2006 and December 14, 2006. Applicant repeats that the coupon data are not scanned or encoded into the wallet card.

Second, the Examiner has not pointed out what essential elements are omitted. As discussed above, claim 1 recites, *inter alia*, (1) identifying selected publicly placed coupons, offering a purchase discount for a selected product, with a notification indicia related to the one of the wallet cards; (2) issuing the purchase discount for the selected product purchased at one of the plurality of retailers by the one of the plurality of consumers upon presentation of the one of the wallet cards; and (3) notifying the management entity of the purchase discount identified to the management entity via the electronic automated means. All the essential elements are recited in the claims.

Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §112, first and second paragraphs be withdrawn.

#### ***Claim Rejections – 35 USC §102***

In the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. 102(b) as being anticipated by Fajkowski, WO 98/19229 ("Fajkowski"). Applicant respectfully traverses the rejection and submits that the Examiner has not established a prima facie case of anticipation.

Fajkowski discloses method and apparatus for coupon management and redemption. A potable coupon card includes a bar code scanner, a memory means, a display screen, and a communication port, all controlled by a microprocessor and operational keys (Fajkowski, page 4, lines 26-30). The bar code scanner allows users to scan into the memory means the bar codes on coupons wherever a user may find the coupons (Fajkowski, page 4, lines 30-31). A consumer inserts the coupon card into a peripheral device positioned along the cash register in a retail store and the periphery device will read coupon bar codes from the coupon card (Fajkowski, page 5, lines 19-22).



Fajkowski does not disclose, either explicitly or implicitly, at least one of: (1) producing a plurality of wallet cards; (2) issuing one of the wallet cards to each of the plurality of consumers; and (3) identifying selected publicly placed coupons, offering a purchase discount for a selected product, with a notification indicia related to the one of the wallet cards, as recited in claim 1-3; (4) issuing a universal coupon card containing information related to coupon card transaction to a consumer, the information corresponding to a coupon identified by a notification indicia and being embedded in the card via an electronic or magnetic medium, the coupon card being redeemable at a retailer to receive a discount for a good or service provided by a manufacturer, as recited in claim 4; and (5) an electronic or magnetic medium to contain information related to coupon card transaction used by a consumer, the information corresponding to a coupon identified by a notification indicia and offering a discount for a good or service, the information being scanned by a retailer when the consumer purchases the good or service to receive the discount, as recited in claim 7.

Fajkowski merely discloses a coupon card to allow users to scan coupon bar codes into the coupon card (Fajkowski, page 4, lines 30-31), not a wallet card related to a notification indicia identifying publicly placed coupons. The coupon card disclosed by Fajkowski contains the coupon bar codes. In contrast, the claimed invention provides a wallet card related to a notification indicia identifying a coupon. The wallet card does not contain the coupon data or the coupon bar codes.

To anticipate a claim, the reference must teach every element of a the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Since the Examiner failed to show that Fajkowski teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Accordingly, Applicant respectfully request the rejection under 35 U.S.C. 102(b) be withdrawn.

***Conclusion***

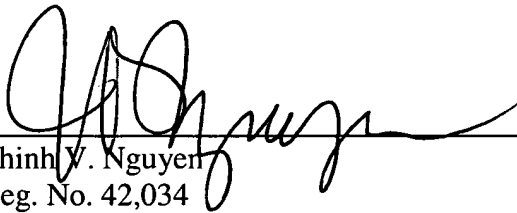
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: March 1, 2007

By



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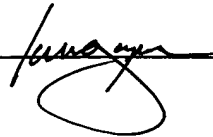
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